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09/936,015	12/11/2001	Andrew George Cordiner	156-025	9278

7590

05/27/2003

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,015

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 12/11/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-68 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 4, 25, 27, 50, 53, 54, 52, 59, 60, 62-64, 67 is/are rejected.
- ☒ Claim(s) 2-3, 5-24, 26, 28-49, 51-52, 55-56, 58, 61, 65-66, 68 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

- ☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1, 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claim Objections

1. Claims 5,6,9,11,12,31,32,34,41,46,58,59,60,67 are objected to because of the following informalities: (1) claims 5,6,9,11,12,22,31,32,34,41,46; on line 1, “claims” should be singular because reference is to a single claim (2) claim 67, (ii), “uncolored” is a mis-spelling (3) claim 6, the left-handed bracket ([) is superfluous. (4) claims 58-60, “fluidisable” is a mis-spelling. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,4,25,27,53,54,57,59,60,62,64,67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1,4,59,62,64,67 are vague and indefinite because the required size of agglomerates, which is a critical aspect of the invention, are not claimed so the intended nature of the composition is unclear.

- Claim 1 is vague and indefinite because at the end of step 2, it is unclear what is meant by the phrase “(ii) has a higher Dv.99 or a higher Dv.50 than...together” in context.

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- Claim 4, step 2a is vague and indefinite because the precise meaning of lines 2-3 is unclear, how can the components meet BOTH (and/or) limitations of the claim?
- Claims 25,27,53,54,57; the reference in the powder coating composition and kit claims to "film formation" renders the claims vague and indefinite because the claims never require the conditions of film forming (there would be an infinite number of film forming conditions).
- Claims 54, 64 are vague and indefinite because the Dv of the colored base components are not provided, which is a critical aspect of the invention.
- Claim 50 is vague and indefinite because the meaning of "each having a higher Dv.99" is unclear since it never states higher than what.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 63 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 459048 (p.2, 33-40) or EP 372860 (p. 3,11-17).

The coated substrate as claimed is the same as, or substantially identical to, the products of the references because the cited references form a coated fused substrate where the particles of the larger sized component is not visible to the naked eye, giving the appearance of a single color, as described by Applicants, see specification page 4, 8-12, page 23, 4-8; etc. Hence the physical descriptions of the claimed product and those of the prior art are the same and claim 63 does not patentably distinguish over the prior art.

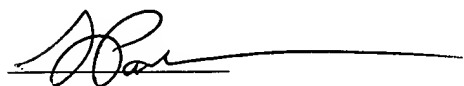
Applicants are reminded that product-by-process claims are based upon the product itself and not by the process by which it is made, see MPEP 2113.

6. The prior art does not teach nor suggest the powder coating composition, process of making, and kit thereof having the express particle size limitations of claims 1,4,50,54,64,67. The closest prior art is as follows: US 6133344, EP 372860 & EP 459048 teach different particle size distributions of colored and non-colored particles which form continuous fused coatings where color differences cannot be ascertained by the human eye. US 6518349 teaches agglomerated sprayable fluoropolymer materials having an average particle size of 5-100 microns which may include pigments and mica without teaching the particle size relationships of the components. US 5856378 discloses composite agglomerated powder coating compositions of individual components which may be applied by electrostatic spraying, but which doesn't teach the particle

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size relationships of the instant invention. It is the Examiner's opinion that the Stated Prior Art does not teach, nor fairly suggest to combine, the cited references to produce the invention in this Application. However, independent and dependant claims are rejected as discussed above. Claims 2-3,5-24,26,28-49,51,52,55,56,58,61,65,66,68 are also objected to for depending from a rejected base claim.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



Fred J. Parker

**FRED J. PARKER
PRIMARY EXAMINER**

May 22, 2003

9-936015